

In particular, independent claim 23 of group II is drawn to a method of releasing stored content items from a server to make room for new content items. This claim is believed to be closely related to claim 1 which relates to a method of loading content to a server in anticipation of a need for content by network clients and determining proximities between sources of content and servers capable of storing the content. In each case a first and second proximity is determined between a server and a second location on the network. Therefore, as discussed further below, applicant respectfully submits that the group II claims, i.e., claims 23-28, should be examined with the claims of group I.

The examiner indicates as a basis for the restriction requirement that inventions I and II are related as subcombinations disclosed as useable together in a single combination. Even if the claims are drawn to patentably distinct or independent inventions, MPEP § 803 provides that “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” Although the scope of the claims of group I and group II varies and applicant agrees that the claims are patentably distinct, many of the claimed features are similar. For example, each of claims 1-12 in group I and claims 23-28 of group II requires determining a proximity between a server and a source of content. Accordingly, although it is acknowledged that the inventions of groups I and II are patentably distinct, applicant respectfully submits that it would not unduly burden the examiner to simultaneously examine the claims of groups I and II.

Moreover, prosecution had commenced in this matter long before the restriction requirement was issued. MPEP section 811 directs that the examiner should make the restriction requirement “as early as possible in the prosecution.” MPEP 811 goes on to state that if the requirement is not made in the first action, it should be made “as soon as the need for a proper requirement develops.”

The application was filed in April 1999 and the first office action was mailed on July 9, 2001, with an amendment in response filed on October 9, 2001. A restriction requirement made on grounds similar to the present restriction requirement was mailed in December 2001 then withdrawn. Since the withdrawal of the restriction requirement, Office actions were mailed by the examiner in May 2002 and December 2002, with amendments filed in response to each. Applicant filed an RCE together with an amendment on May 9, limiting the scope of claim 23 by eliminating one of the members of the Markush group. Amendments were made to several of

the claims of the Group I claims. For example, claim 1 was amended to include the limitations of claim 12, previously noted to be allowable.

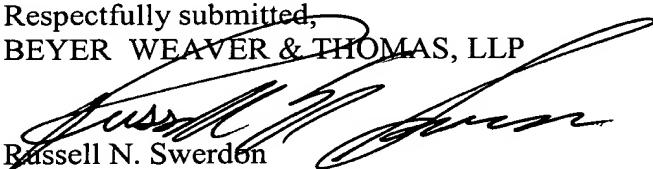
The grounds for withdrawing the present restriction requirement are even more compelling than those in effect at the time of the December 2001 restriction requirement. Significant progress has been made towards furthering the prosecution of the invention to the point that based on the Examiner's previously comments about allowable subject matter, at least claims 1-12 presently are in allowable form. At the time of the previous restriction requirement, the examiner felt that claims 23-28 were drawn to the same class, i.e., a congestion avoiding classified in class 709, subclass 235. In identifying art of record in each of the previous office actions, it is clear that the examiner searched art for claims which included claims 1-15 and 23-28. None of the amendments present changed circumstances which would warrant imposing a restriction requirement at this point. Given the progress made in prosecuting this matter to date, the guidelines provided in MPEP 811 direct that the restriction requirement be withdrawn.

MPEP 811 also states that "before making a restriction requirement after the first action on the merits, the examiner will consider whether there will be a serious burden if the restriction is not required." Applicant submits that no serious burden will result if the restriction is not required. The entire claimed invention has already been searched in preparation of the first office action. The different claim groups identified in the new restriction requirement have been previously searched commencing in December 2001 and are sufficiently close that an updated search can be conducted of all claims without significant burden. The filing of the RCE is treated by the Patent Office as the continued examination of the same application. It does not permit evisceration of the guidelines set forth in MPEP 811.

Conclusion

Therefore, for the substantive and procedural reasons identified above, applicant respectfully submits that the claims of Group II (i.e., claims 23-28) should be examined with the claims of Group I. If the examiner believes that a telephone conference would expedite the prosecution of this application, he is invited to contact the applicant's undersigned attorney at the telephone number set out below.

Respectfully submitted,
BEYER WEAVER & THOMAS, LLP


Russell N. Swerdlow
Registration No. 36,943

P.O. Box 778
Berkeley, CA 94704-0778
(510) 843-6200